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09/578,236	05/24/2000	Marion Sterner	M1025/7001	5409

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EXAMINER

EASHOO, MARK

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 110304

Application Number: 09/578,236
Filing Date: May 24, 2000
Appellant(s): STERNER ET AL.

Dr. Mark Eashoo
For Appellant

EXAMINER'S ANSWER

MAILED
MAR 22 2004
GROUP 1700

This is in response to the appeal brief filed 20-JAN-2004.

Art Unit: 1732

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. For clarity, it is noted that no claims have been canceled as indicted by the blank space in applicant's brief.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because applicant's summary includes arguments against the Final rejection and incorrectly suggests that the film material, or polymer itself, is modified rather than a modification of the characteristics of the overall film.

A correct summary of the invention is set forth in the original specification on pg. 2, li. 23 through pg. 3, li. 19.

(6) *Issues*

Appellant's brief presents arguments relating to whether a statement in applicant's specification regarding the prior art has been properly construed by the examiner. This is not proper appealable subject matter, however, it would intrinsically be considered

Art Unit: 1732

while evaluating the rejection made under 35 USC 103, whether claims 1-16 are unpatentable over applicant's admitted prior art (admission) in view of Siol et al. (US Pat. 4,814,207), which is listed as "5" in applicant's brief under the sub-heading of "Issues".

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

A substantially correct copy of appealed claims 1-16 appears on pages 9-12 of to the appellant's brief (ie. the Appendix). The minor error is as follows:

Claim 5, lines 4 and 5 which read "titanium;" and "acetyl acetate;" should read as one line -- titanium acetyl acetate; --.

(9) *Prior Art of Record*

6,024,824	KRECH	2-2000
4,814,207	SIOL ET AL.	3-1989

Applicant's admitted prior art (Admission), "Original Specification", (May 24, 2000), pp.1-2.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Krech (US Pat.6,024,825). This rejection is set forth in prior Office Action, Paper No. 14.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as obvious over Siol et al. (US Pat.4,814,207). This rejection is set forth in prior Office Action, Paper No. 14.

Claims 4 and 6 are rejected under 35 USC 103(a) as being unpatentable over Siol et al. (US Pat.4,814,207). This rejection is set forth in prior Office Action, Paper No. 14.

Claims 1-16 are rejected under 35 USC 103(a) as unpatentable over applicant's admitted prior art or Admission (original specification, pgs. 1-2) in view of over Siol et al. (US Pat.4,814,207). This rejection is set forth in prior Office Action, Paper No. 14.

(II) Response to Argument

Claims 1-5 and 16 are anticipated by Krech (US Pat.6,024,825):

Applicant broadly alleges that Krech does not teach "any" of the instantly claim elements/limitations recited in claim 1. Nonetheless, applicant specifically argues two main issues, namely, that the particles of Krech are not an "active substance" and the particles do not modify the properties of the "polymer material".

Applicant's arguments are not persuasive because applicant's own definition is inclusive of particulates as evidenced by claim 16, which plainly recites micro-fibers which vary the mechanical and/or surface strength characteristics of the film. It is submitted that the particulates of Krech would act in the same manner, to some degree, as the micro-fibers. Furthermore, applicant's original specification suggests that micro-capsules and reinforcing fibers, therefore particles, may be used as an "active substance" (see specification pg. 8). It is noted that the micro-capsules are taught that "active substances may be contained therein", whereas Krech teaches that the particles may be coated with "silanes" to increase adhesion to organic materials (9:15-20). Silanes are recited as an active substance in instant claim 5. It is maintained that the particles of Krech meets the broad limitation of "active substance".

Applicant's argument suggest that the particles of Krech do not modify the properties of the "polymer material". First of all, the claim recites "to modify selected characteristics of the film" and not the polymer material. Again, claim 16 provides evidence that particles which are incorporated into (ie. even partially embedded) into a film would vary some mechanical characteristics of the film. Furthermore, the limitation "selected characteristics" is very broad and readable upon any characteristic of the film. Nonetheless, it is submitted that the particles taught by Krech are non-transparent (8:21-45) and would inherently effect the overall characteristic of

Art Unit: 1732

the film as a barrier against electromagnetic waves such as UV rays. Providing such a barrier was specifically one of the selected characteristics of the film as evidenced by instant claim 6. It is also maintained that the particles of Krech meets the broad limitation of "to modify selected characteristics of the film".

Claims 1-3 are anticipated by Siol et al. (US Pat.4,814,207):

Applicant specifically argues two main issues, namely, that Siol et al. does not teach applying the active substance at a temperature above ambient temperature and the applied active substance do not modify the characteristics/properties of the film.

Applicant's first argument is not persuasive because the argument completely ignores the direct teaching of "elevated temperatures" by Siol et al. which clearly states (8:16-20), "For example, the continuous production of plastic panels by extrusion may be followed by continuous coating of the panels, which may still be at elevated temperatures, but which should be below the glass transition temperature of the plastic panel." It is submitted that a person having ordinary skill in the art would not use the term "elevated temperatures" if it were intended to describe a temperature below ambient (ie. room temperature).

Applicant's second argument is not persuasive because the argument ignores the position taken by the examiner that the coating material would inherently penetrate into the surface of the film (ie. molecular diffusion). It is inherent that the properties of both at such boundary layer, where molecular diffusion occurs, is influenced in some degree by both materials. Therefore, at least the surface of the original film is changed by diffusion and therefore the surface characteristics must be different than that of an uncoated film surface. Applicant's argument also over looks that the breadth of the limitation "to modify selected characteristics of the film" is readable upon the an overall multilayer film because the preamble states "a plastic film" without regards to the number of layers wherein the 'film'. It is noted that the term "single body of film" is not narrow enough to solely suggest a single layer film but rather readable upon the film being a 'unified body'.

Discussion of applicant's admitted prior art and claims 1-16 with Siol et al.:

It is noted that the comments made above regarding claims 1-3 and Siol et al. can be considered to be applied to all claims, 1-16 in addition to the following comments regarding applicant's admitted prior art.

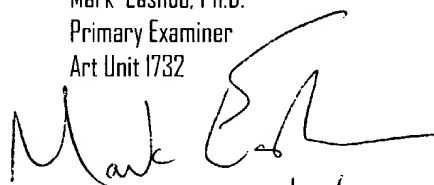
Art Unit: 1732

Applicant's argument suggests that the teachings in the Background section of the original specification is interpreted by the examiner as a teaching of applying an active substance on a film at elevated during an extrusion process. However, the rejection based upon applicant's admitted prior art does not take such position, rather that position is why the teachings of Siol et al. were added to the rejection made under 35 USC 103(a). Furthermore, the examiner's cited teaching of applicant's admitted prior art are essentially quotes from applicant's own specification which suggests that no mis-interpretation of applicant's admission occurs in the rejection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732


11/ Mar / 04

me
March 11, 2004

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